

REMARKS

The Examiner's Action of August 6, 2003 has been received and its contents carefully considered. Reconsideration is respectfully requested in view of the amendment and the following comments.

Claims 1-3 and 8-27 are currently pending in the instant application.

I. Amendments to independent claims 1 and 17

Independent claims 1 and 17 have been amended to recite that embodiments of the invention encompass alloys that comprise one of Nb and Ta, and therefore not both. Support for the above change can be found in the original specification, for example in the Example starting at page 12.

II. Rejections under 35 USC 103(a)

Claims 1-3, 9-11, 16-18, 20-22 and 27 have been rejected under Section 103(a) as being unpatentable over Araya et al. (JP 10-219375). Claims 8 and 19 have been rejected under Section 103(a) as being unpatentable over Araya et al. in view of Farzin-Nia et al. Claims 12 and 23 have been rejected under Section 103(a) as being unpatentable over Araya et al. in view of Beyar et al. Claims 13 and 24 have been rejected under Section 103 (a) a being unpatentable over Araya et al. in view of Regan. Claims 14 and 25 have been rejected under Section 103(a) as being unpatentable over Araya et al. in view of Kizelshteyn et al. Claims 15 and 26 have been rejected under Section 103 (a) a being unpatentable over Araya et al. in view of Besselink et al.

Reconsideration is respectfully requested in view of the amendment and the following comments.

All of the pending claims have been rejected under Section 103(a) as being unpatentable over Araya et al. as the sole reference or as the primary reference combined with another reference.

As an initial matter, independent claims 1 and 17 as amended require that the alloy comprises both Sn and “one of” Nb and Ta, as opposed to Sn and “at least one of” Nb and Ta recited prior to the instant amendments. Araya et al. require that Sn and both Nb and Ta be present in the alloy, and thus teach away from eliminating any of Nb and Ta from the alloy containing Sn. In addition, the data present in Araya et al. all show the presence of Sn along with both Nb and Ta. The teaching of either Nb or Ta being present in the alloy is not only missing from Araya et al., it is taught away from in the reference.

Moreover, independent claims 1 and 17 are both directed to an alloy comprising Sn in an amount of 3-6%. Regarding Araya et al, the Office Action states that “[t]hough Araya et al. fail to meet the claimed range of tin, the range taught by Araya et al is close enough to the presently claimed range that one of ordinary skill in the art would have expected the two alloys to have the same properties.” First, as set forth in the response filed on June 20, 2003, Araya et al. expressly teach away from an Sn range in an amount of 3-6%. Araya et al. expressly state that the Sn should be present at no more than 5wt%, which is less than the range specified in claim 1. Araya et al. add that observance of the stated ranges of the components of their alloy enhances the stability of the same. Thus, a person of ordinary skill would in fact be led away from increasing the amount of Sn present in Araya et al. alloy. The Examiner is using impermissible hindsight.

Clearly, the only motivation for the modification of the stated range for Sn comes from Applicants' own invention.

In view of the above, it is submitted that independent claims 1 and 17 are patentable over Araya et al. In addition, it is submitted that independent claims 2, 3, 9-11, 16-18, 20-22 and 27 are patentable over Araya et al. by virtue of being dependent from independent claims 1 or 17, and further for the particular additional features that they recite.

In addition, none of the secondary references overcome the deficiencies of Araya et al. noted above. Thus, it is submitted that all of the pending claims are patentable over the cited combination of references.


CONCLUSION

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration, withdrawal of all grounds of rejection and issuance of a Notice of Allowance are solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. ' 1.16 or ' 1.17 to Deposit Account No. 11-0600. The Examiner is invited to contact the undersigned at (202) 220-4296 to discuss any matter regarding this application.

Respectfully submitted,
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